

REMARKS

In the Final Office Action¹, the Examiner rejected claims 1-5 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement; and rejected claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,714,797 to Rautila ("*Rautila*") in view of U.S. Patent No. 4,300,040 to Gould et al. ("*Gould*") and alternatively, as unpatentable over *Rautila* in view of U.S. Patent No. 5,918,213 to Bernard et al. ("*Bernard*").

Applicants respectfully traverse the rejection of claims 1-5 under 35 U.S.C. § 112, first paragraph. The Final Office Action (at p. 3) alleges that "an identification code for individually identifying electronic content retrieved from among the available electronic contents," as recited in claim 1 contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention (emphasis in original). According to the Final Office Action, "[n]o support for this new amendment can be found in the applicant's disclosure" (Id.) Applicants respectfully disagree.

Support for the claimed identification code may be found, for example, on pages 16 and 20 of Applicants' specification. For example, on page 20, the specification provides: "[t]he store terminals 5A to 5N simultaneously download an ID code corresponding to each music content from the ID server 15 of the online system 8A, whereby an ID server 19 is formed."

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Furthermore, according to the guidelines for the examination of patent applications under 35 U.S.C. § 112, as set forth in M.P.E.P. § 2163, the Examiner must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden of presenting, by a preponderance of evidence, why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Because a person of ordinary skill in the art would recognize a description of "an identification code for individually identifying electronic content retrieved from among the available electronic contents," as recited in claim 1, the rejection of claims 1-5 under 35 U.S.C. § 112, first paragraph is improper and should be withdrawn.

Applicants respectfully traverse the rejection of claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over *Rautila* in view of *Gould*, and alternatively over *Rautila* in view of *Bernard*. Even if combinable as suggested by the Examiner, both combinations fail to teach or suggest each and every element of claims 1-5.

For example, claim 1 recites an electronic content providing method, comprising, among other things, the step of:

acquiring an identification code for individually identifying electronic content retrieved from among the available electronic contents by using said remote user terminal linked via a network to a server in which the available electronic contents are recorded.

According to the Examiner, *Rautila* discloses, at col. 6, lines 35-40 and col. 8, lines 31-37, acquiring an identification code for individually identifying electronic content retrieved from among the available electronic contents by using said user terminal linked via a network to a server in which the available electronic contents are recorded (Final Office Action at p. 4). Applicants respectfully disagree.

Rautila, at col. 6, lines 35-40, discloses that, whether a user decides to have an electronic product downloaded at a hotspot network location or via the cellular phone capability of the mobile station, a unique order number is transmitted to the mobile station by the electronic shop server. At col. 8, lines 31-37, *Rautila* also discloses that whether the user selects to download the digital product at a hotspot network location or via cellular transmission, the user then receives a unique order number. According to *Rautila*, the operation processing of the order/location module then terminates.

In addressing Applicants' remarks set forth in a previous response, the Examiner asserts, "the unique order number is used to obtain the desired product from the electronic shop server" and states, "an identification code for individually identifying electronic content retrieved from among the available electronic contents" is met by the cited portion of *Rautila* (Final Office Action at p. 2). Applicants respectfully disagree because, while *Rautila* may disclose transmitting a unique order number to initiate content downloading, *Rautila* does not disclose the claimed electronic content providing method.

Indeed, because the unique order number in *Rautila*, at col. 9, lines 60-61, explicitly corresponds to the mobile device which receives downloaded content, the ordered digital product, and the identified hotspot network location, *Rautila* does not and cannot disclose an identification code for individually identifying electronic content retrieved from among the available electronic contents.

Gould also fails to disclose the claimed electronic content providing method. According to the Examiner, *Gould* discloses that after inputting code representing selected content, the user can view a preview of the selected content prior to

purchasing the selected content (Final Office Action at p. 4). The numerical code in *Gould*, at col. 2, lines 33-35, represents selected videocassette program material in a previewing station.

Because the numerical code in *Gould* is entered by a customer at a terminal previewing station, *Gould* also fails to disclose acquiring an identification code for individually identifying electronic content retrieved from among the available electronic contents by using a remote user terminal linked via a network to a server in which the available electronic contents are recorded, as recited in claim 1.

Bernard also fails to disclose the claimed electronic content providing method. According to the Examiner, *Bernard* discloses, at col. 3, lines 8-41, product samples, such as movie previews, sample cuts from music tracks, software demo, and the like, provided to the customer so the customer can evaluate the product prior to purchasing (Final Office Action at pp. 5-6). While *Bernard* may disclose allowing users to shop for and purchase products via a remote communication medium, *Bernard* fails to disclose the claimed step of acquiring an identification code for individually identifying electronic content retrieved from among the available electronic contents, as recited in claim 1.

Rautila, *Gould*, and *Bernard*, even if combined as argued by the Examiner, thus do not disclose or suggest each and every element of the electronic content providing method in claim 1. For at least these reasons, Applicants respectfully request that the Examiner withdraw the rejections of claim 1 under 35 U.S.C. § 103(a).

Independent claims 2-5, although of different scope than claim 1, are allowable for at least the same reasons that independent claim 1 is allowable.

Applicants respectfully request that this response under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-5 in condition for allowance.

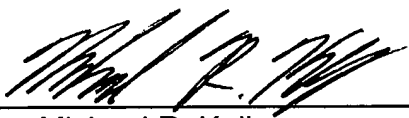
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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